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09/525,491	03/15/2000	Mary Thomasma Tackbary	9203/031c3	9815

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 04/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/525,491

Applicant(s)

TACKBARY ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25,28,29,31-43 and 45-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25,28,29,31-43 and 45-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

3. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 28 depends on Claim 27 which was cancelled in Preliminary Amendment B, 21 March 2002.

### ***Claim Rejections - 35 USC § 101***

#### ***Double Patenting***

The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 18, 29, 31, 32, 36, 45, 57, and 69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 23 of U.S. Patent No. 5,555,496, claims 1, 32, 38, 45, 46, 47, 51, 68, 72, and 73 of U.S. Patent No. 5,960,412, and claims 1, 11, 21, 31, 41, 45, and 49 of U.S. Patent No. 6,092,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application claim subject matter pertaining to system, method, means, and program code of electronically viewing, ordering, and delivering a social expression card to a recipient.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

- 5. Claims 1-15, 18-25, 29, 31-43, 45, 50-57, 62-69, and 74-80 are rejected under 35 USC 102(e) as being anticipated by Cannon et al, patent number 5,552,994.**

Cannon et al teaches all the limitations of Claims 1-15, 18-25, 29, 31-43, 45, 50-57, 62-69, and 74-80. For example, Cannon et al discloses a system, method, means, databases, and programs for viewing, ordering, and printing social expression cards for customers who remotely order greeting cards over a computer network. Cannon et al teaches printing cards at the user location or at remote locations, a database defining the layout of selected cards by occasion, displaying graphical images, personalizing messages, transacting multiple card orders, recipient information, envelop printing, and a mail delivery mode. Cannon et al further teaches a known problem of card purchasers not remembering what card designs they have previously sent to a recipient and concerns about

sending duplicates of cards previously sent, an order information database, order information storage and retrieval, and unique order identifiers to retrieve orders. Inherent in the system, method, means and database structures of Cannon et al is linking database items and the ability to link a single card selection to a plurality of recipients by changing the hard-coded recipient name to a pointer that links to an imported mailing list (see at least abstract; Fig. 1 (15, 19); Fig. 3 (40, 50); 3a (36); Fig. 18 (52, 54, 66, 67, 68); Fig. 19 (71); col. 1, line 15 through col. 5, line 39; col. 6, line 63;

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claim 16 is rejected under 35 USC 103(a) as being unpatentable over Cannon et al.**

Cannon et al teaches all the above as noted under the 102(e) rejection but fails to disclose reading a printed order using an optical character reader.

Cannon et al further teaches optical scanning, bar coding to identify orders and cards, order retrieval, ASCII text characters in orders, and reading bar-coded orders. Therefore it would have been obvious to one of ordinary skill in the art at

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time of the invention to modify the system, method, and means of Cannon et al to include optical character scanning of orders in order to improve card fulfillment efficiency and thereby lower processing costs.

- 7. Claims 17, 48, 49, 60, 61, 72, and 73 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al in view of Hayes ("1992 American Catalog Awards-Apparel Over \$100: Bullock & Jones: A Simple Story Well Told," Catalog Age, v9n9pp: 120-121, Dialog file 15 #00639323).**

Cannon et al teaches electronic shopping, ordering, and delivering of social expression cards but fails to disclose selecting a gift to be included with the card. Hayes teaches Bullock & Jones combining a gift with a card selected through a mail-order catalog shopping service that offers various forms of electronic shopping to better service customers. This examiner takes the position that the system and method of Bullock & Jones extends to electronic shoppers a complete social occasion service old and well known to traditional in-store customers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al to provide a card and gift combination as taught by Hayes, in order to extend to electronic shoppers a social occasion service capable of providing customers with a complete gift purchasing and card giving service and thereby attracting more convenience-seeking customers.

**8. Claims 46, 47, 58, 59, 70, and 71 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al.**

Cannon et al teaches all the above as noted under the 102(e) rejection and further teaches occasion delivery date, addressing envelopes, flagging order completion prior to mail delivery, card purchasers forgetting to mail cards on time, and using mail or other means of delivery, but fails to specifically disclose multiple modes of mail delivery. It is old and well known to use express couriers under circumstances where urgent delivery is required to meet a certain delivery date or speed delivery once past a certain delivery date, and therefore it would have been obvious to one of ordinary skill in the art at time of invention to modify the system, method, and means of Cannon et al to include multiple modes of mail delivery in order to better service the customer and attract repeat business.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:00AM-5:00PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344.

The fax phone numbers for the organization where this application or proceeding




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is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

RMP  
April 15, 2002

  
WYNN COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100